

REMARKS

Status Summary

In this Amendment claims 43-46 are added, and no claims are canceled. Therefore, upon entry of this Amendment, claims 1, 3-7, and 10-46 will be pending.

Telephone Examiner Interview

Applicants greatly appreciate telephone Examiner interview granted them on October 28, 2004. In the telephone examiner interview, the claim rejections pursuant to 35 U.S.C. § 101 as well as the prior art rejections were discussed. With regard to the claim rejections under 35 U.S.C. § 101, the Examiner indicated that the case law required "a transformation of data" in order for method claims to be considered statutory subject matter under 35 U.S.C. § 101. In addition, the Examiner indicated that method claims were treated differently than device claims under 35 U.S.C. § 101. For the reasons set forth below, applicants respectively submit that the claims recite statutory subject matter under 35 U.S.C. § 101.

In the telephone examiner interview, the Examiner referenced *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), *AT&T Corp v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), and *In re Alappat* 33 F.3d 1526 (Fed. Cir. 1994) as supporting both of the above referenced assertions. In *State Street*, the Court stated:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories a claim is directed to process, machine, manufacture, or composition of matter but rather on the essential characteristics of the subject matter, in particular, its practical utility. (Emphasis Added.) (*State Street*, 149 F.3d at 1378)

Thus, from this passage, the question of statutory subject matter is whether or not the subject matter being claimed has been applied in some practical way. As stated in the telephone examiner interview and as discussed in detail below, all of the claims at issue recite automatically generating a complaint registration message that identifies a communications initiator and sending the complaint registration message to complaint registration server. The generating and sending of a message that identifies an unwanted call is a practical application of the invention. Thus, applicants respectfully submit that the claims are patentable under guidelines set forth by the Court in *State Street*.

In *AT&T v. Excel Communications*, the claims at issue recited the addition of a data field in a standard message record that indicated the primary interexchange carrier for a call to enable differential billing (See *AT&T*, 172 F.3d at 1354). The claims were held to be statutory subject matter under 35 U.S.C. § 101. In *AA&T*, the claims related to generating a new message record in telecommunications environment for billing purposes. The claims at issue in the subject application include generating a new message, i.e., the complaint registration message, and sending the message to complaint registration server. Since a new message inherently includes new fields, the claims at issue in the present application are of the same type of subject matter as the claims in *AT&T*. Thus, based on factual similarities to the claims in *AT&T*, applicants respectfully submit that the method claims at issue in the subject application constitute statutory subject matter.

Moreover, with regard to whether method claims should be treated differently than device claims for statutory subject matter purposes, the Court in *AT&T* stated:

Whether stated implicitly or explicitly, we consider the scope of Section 101 to be the same regardless of the form -- machine or process -- in which a particular claim is drafted. (See *AT&T*, 172 F.3d at 1358)

Thus, from this passage, the method claims in the subject application should be treated the same as the apparatus claims. In the interview, the Examiner indicated that the apparatus claims constituted statutory subject matter. The method claims, like the apparatus claims recite generation of the complaint registration message. As a result, it is respectfully submitted that the method and apparatus claims constitute statutory subject matter under 35 U.S.C. § 101.

In *re Alappat*, the subject matter at issue was an anti-aliasing algorithm for a rasterized display. The Court held that the claims constituted statutory subject matter and reiterated the intent of Congress that 35 U.S.C. § 101 be constructed broadly to include anything under the sun that is made by man (See *Alappat*, 33 F.3d at 1545). The Court stated that proper inquiry under 35 U.S.C. § 101 is, "to see whether the claimed subject matter as a whole is a disembodied mathematical concept, whether categorized as a mathematical formula, mathematical equation, mathematical algorithm or the like, which in essence represents nothing more than a "law of nature, " "natural phenomenon" or "abstract idea." (*Alappat*, 33 F.3d at 1551) When considered as a whole, applicants' invention is not a natural phenomenon, law of nature or an abstract idea. The claims in the subject application recite methods for automatically registering complaints against communications initiators. The methods include extracting parameters from call signaling messages, determining whether a call or other communication is unwanted, and automatically forwarding a complaint registration message to a complaint registration server. When taken as a whole, the claims recite a practical solution to a problem that

exists with conventional call screening methods. Accordingly, under *Alappat*, the claims of subject application recite statutory subject matter under 35 U.S.C. § 101.

With regard to the requirement stated by the Examiner in the interview that the claims recite some "transformation of data," applicants respectfully submit that the generation of the complaint registration message including parameters extracted from the original signaling message represents such a transformation. If the generation of a new message that did not exist before does not represent a transformation of data, then the Examiner's interpretation of the transformation requirement is impossible to meet. Accordingly, for this additional reason, it is respectfully submitted that the claims constitute statutory subject matter under 35 U.S.C. § 101.

For all of the reasons stated above and the reasons stated below, applicants respectfully submit that the rejection of the claims under 35 U.S.C. § 101 and the prior art rejections be withdrawn.

Claim Rejections 35 U.S.C. § 101

Claims 1, 3-7, and 10-39 were rejected under 35 U.S.C. § 101 as being directed to abstract ideas. This rejection is respectfully traversed.

35 U.S.C. § 101 recites categories of statutory subject matter. The categories include new and useful processes, machines, manufactures, compositions of matter, or any new and useful improvements thereof. These categories have been broadly interpreted to include almost anything under the sun made by man. (See *Diamond v. Chakrabarty*, 447 U.S. 303 (S. Ct. 1980).) For computer-related inventions, 35 U.S.C. § 101 has been interpreted to require that the invention achieve a practical application. (See M.P.E.P. §

2106 (b)(ii).) Independent claims 1, 20, and 26 recite methods and systems and practical applications thereof that are well within these categories. For example, independent claim 1 recites a method for registering complaints against communication initiators. The method includes the steps of receiving a signaling message from a communication initiator, extracting a parameter from the signaling message, determining, based on the parameter, whether the communication is from a communication initiator with whom communication is not desired, and, in response to determining that the communication is from a communication initiator with whom communication is not desired, generating, from a user communications terminal or end office to which the communication is directed, a complaint registration message identifying the communications initiator using information extracted from the signaling message, and transmitting the complaint registration message to a complaint registration server. The practical application recited in claim 1 is the generation of the complaint registration message including information extracted from the signaling message that identifies the communications initiator and sending the complaint registration message to a complaint registration server. Applicants respectfully submit that these steps and this application are well within the statutory category of a process as required by 35 U.S.C. § 101. Independent claim 20 also recites steps similar to claim 1 for generating a complaint registration message including information identifying a communications initiator and transmitting the complaint registration message to a complaint registration server. Thus, for the same reasons stated with regard to claim 1, it is respectfully submitted that claim 20 is statutory subject matter under 35 U.S.C. § 101.

Claim 26 recites a system including a communications terminal and a complaint registration server. The communications terminal receives communications and signaling

messages associated with the communications from communications initiators. The communications determines whether a communication is from a communications initiator with whom communication is not desired. In response to determining that the communication is from a communications initiator with whom communication is not desired, the communications terminal generates and forwards a complaint registration message identifying the initiator to the complaint registration server. The complaint registration server receives and processes the complaint registration message. Because claim 26 recites a communications terminal and a complaint registration server that co-operate to register complaints against communications initiators, it is respectfully submitted that these elements fall within the statutory category of a machine or an article of manufacture. Accordingly, it is respectfully submitted that claim 26 constitutes statutory subject matter under 35 U.S.C. § 101. Because independent claims 1, 20, and 26 recite statutory subject matter, it is respectfully submitted that their dependent claims also recite statutory subject matter. Accordingly, it is respectfully requested that the rejection of claims 1, 3-7, and 10-39 under 35 U.S.C. § 101 as being directed to abstract ideas is improper and should be withdrawn.

Claim Rejections 35 U.S.C. § 103

Claims 1, 4, 6, 10-12, 15, 20-22, 26, 31, 32, 34-36, 38, 40, and 42 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,751,800 to Ardon (hereinafter, "Ardon") in view of U.S. Patent No. 5,668,953 to Sloo (hereinafter, "Sloo"). This rejection is respectfully traversed.

Independent claim 1 recites a method for registering complaints against communications initiators. The method includes receiving a signaling message is received

from the communications initiator. The signaling message relates to a communication from the communications initiator. For example, the call signaling message may be a call setup message relating to a telephone call or a signaling message related to SMS delivery. A parameter is extracted from the signaling message and is used to determine whether the communication is from a communication initiator with whom communication is not desired. In response to determining that the communication is from a communication initiator with whom communication is not desired, a complaint registration message is generated, from the user communication terminal or a service switching point to which the original communication was destined. The complaint registration message includes information extracted from the signaling message for identifying the communications initiator and is transmitted to a complaint registration server. Support for the complaint registration message being generated by the communications terminal that received the initial communication is supported, for example, by page 12, lines 13 through 19 of the present specification. Support for the complaint registration message being generated by the service switching point is found, for example, page 21, lines 9 through 24 of the present specification.

As stated in the background section of the present specification, one problem with conventional call screening methods is that subscribers do not know to whom to complain in response to repeated unwanted phone calls. In addition, there is no easy consistent way to document violations of laws pertaining to unwanted communications. (See page 4, lines 1-5 of the present specification.) In order to solve these problems, claim 1 includes generating, from the user communications terminal or end office to which an unwanted communication is directed, a message identifying the communication initiator and transmitting the complaint

registration database to a complaint registration server. In other words, the same communication terminal or end office that receives the call or other communication generates a complaint registration message identifying the initiator and sends the message to a complaint registration server. As a result, the user is not required to know where to send the message or how to identify the communications initiator and additional network equipment is not required.

There is absolutely no teaching or suggestion in Ardon of generating a complaint registration message based on an unwanted communication, not to mention generating a message that identifies the communications initiator using information extracted from the signaling message and transmitting the message to a complaint registration server. Ardon is directed to conventional switch-based call screening where calls are screened based on a call type at a telecommunications switch. The only actions performed by the switch are completing the call (see column 4, line 12 of Ardon), rejecting the call (see column 4, line 17 of Ardon) or playing an announcement (see column 4, lines 33-36 of Ardon). None of these actions teach or suggest generating a complaint registration message from the recipient communications terminal or end office or forwarding the message to a complaint registration server.

Moreover, Ardon teaches that a special code, rather than caller identification information, is used to determine the proper course of action. Thus, Ardon likewise fails to teach generating a complaint registration message including information extracted from a signaling message that identifies the initiator.

The fact that Ardon fails to teach or suggest generating a complaint registration message is admitted on page 1 of the Official Action. However, the Official Action

concludes that Sloo teaches generating a complaint registration message. As a preliminary matter, Applicants respectfully submit that it would not have been obvious to a person of ordinary skill in the art to combine the teachings of Ardon and Sloo because they are directed to unrelated technological areas and to different problems. Ardon is directed to conventional switch-based call screening. Sloo is directed to an anonymous complaint resolution system that allows users to anonymously input and resolve complaints and via a set of computer terminals. In other words, Sloo is directed to a mechanism for dispute resolution and Ardon is directed to a telecommunications. It is respectfully submitted that although disputes can sometimes arise in telecommunications, there is absolutely no motivation in Ardon, Sloo, or in the knowledge available to a person of ordinary skill in the telecommunications or the dispute resolution art to combine the teachings of the references. Accordingly, for this reason alone, it is respectfully submitted that the rejection of the claims as unpatentable over Ardon in view of Sloo should be withdrawn.

In addition, even assuming for the sake of argument that it would have been obvious to combine the teachings of Ardon and Sloo, the combination fails to teach or even remotely suggest the invention claimed in claim 1. For example, claim 1 recites that the complaint registration message is generated from the communications terminal or the end office that received the initial unwanted communication. As stated above, Ardon fails to disclose any generation of a complaint registration message. According to Sloo, a user is required to go to access terminal 14 in order to register a complaint. (See column 3, lines 63-66 of Sloo.) Thus, Sloo requires additional equipment not required by the invention to register complaints. Accordingly, for this additional reason, the rejection of claim 1 as unpatentable over Ardon in view of Sloo should be withdrawn.

Claim 1 also recites that the complaint registration message includes information extracted from the signaling message for identifying the initiator. Ardon teaches that a non-subscriber-identifying code is used to identify unwanted calls. Sloo teaches that a complainant manually inputs information identifying the subject of the complaint (See column 3, lines 63-66 of Sloo.) Since neither Ardon nor Sloo suggest extracting initiator-identifying information from a signaling message and including that information in a complaint registration message, claim 1 is patentable over Ardon and Sloo for this additional reason.

Claim 20 recites a method for registering complaints against communications initiators where the steps are performed at a user communications terminal. In claim 20, the user communications terminal determines whether the communications initiator has been previously notified not to initiate communications with the communications recipient and automatically generates and transmits a complaint registration message identifying the initiator to a complaint registration server. Thus, claim 20, like claim 1, recites that at least some of the same equipment used to receive calls or other communications is used to automatically generate the complaint registration message and transmit the complaint registration message to a complaint registration server.

For the same reasons stated above, it would not have been obvious to combine the teachings of Ardon and Sloo. Moreover, even assuming for the sake of argument that it would have been obvious to combine these teachings, the combination of Ardon and Sloo fails to teach or suggest a communications terminal to which the original communication was directed that automatically generates the complaint registration message. As stated above, Ardon fails to teach or suggest generating a complaint registration message, and

Sloo teaches that a specialized computer terminal unrelated to any communication with the complainant is required in order for the user to submit a complaint. Accordingly, the combination of Ardon and Sloo fails to teach or suggest automatically generating a complaint registration message from the user communications terminal to which the original communication was directed.

Another feature of claim 20 that is not taught by the combination of Ardon and Sloo is automatically generating the complaint registration message in response to determining that the communication initiator has been previously notified not to initiate communications with a communications recipient. According to Ardon:

In this example the subscriber associated with CPE 20 has previously determined not to accept call from a telemarketer (call type “*7”). In this example, the “1” in column 68 defines the call type handling in which central office switch 12 is instructed to deny completion from the switch to CPE 20 for incoming type “*7” calls. (See column 3, lines 33-39 of Ardon.)

From this passage, Ardon indicates that calls are blocked when the recipient has determined not to accept calls of a certain type. There is absolutely no teaching or suggestion in Ardon of identifying calls associated with a communications initiator that has been previously informed not to initiate communications with the communication recipient. Sloo mentions allowing users to browse complaints against subjects (see column 7, lines 8-10 of Sloo), but there is no teaching or suggestion of identifying repeat offenders or automatically generation violation notification messages responsive to the identification. Accordingly, for this additional reason, the rejection claim 20 as unpatentable over Ardon in view of Sloo should be withdrawn.

Independent claim 26 recites a system for registering complaints against the communications initiator. The system includes a communications terminal and a complaint registration server. The communications terminal receives communications and signaling messages associated with the communications. An example of such a communications terminal is a SIP phone. The communications terminal identifies signaling messages associated with unwanted communications and automatically generates and transmits a complaint registration message identifying the initiator to a complaint registration server. The complaint registration server performs complaint registration processing.

As stated above, it would not have been obvious at the time the invention was made to combine the teachings of Ardon and Sloo. Moreover, even assuming for the sake of argument that it would have been obvious to combine these teachings, the combination would not yield the invention claimed in claim 26. For example, claim 26 recites that the communications terminal to which the original communication was directed automatically generates the complaint registration message and that the message includes initiator-identifying information. Ardon fails to teach or suggest the generation of any complaint registration message, and Sloo teaches that a specialized, stand-alone communications terminal is required to register a complaint. Accordingly, it is respectfully submitted that the rejection of claim 26 as unpatentable over Sloo in view of Ardon should be withdrawn.

Claims 4-6, 21, 32, 34-36, 38, 40, and 42 depend from one of claims 1, 20, and 26. As a result, it is respectfully submitted that these claims are patentable over Ardon in view of Sloo for the same reasons that the independent claims are patentable over Ardon in view of Sloo.

Claims 3, 5, 7, 16, and 29 were rejected as unpatentable over Ardon and Sloo. This rejection is respectfully traversed.

Claims 3, 5, 7, 16, and 29 depend either from claim 1 or claim 26. As stated above, Ardon and Sloo fail to teach or suggest generating a complaint registration message and sending the complaint registration message from a user communications terminal or end office to which the initial communication is directed. Ardon and Sloo likewise fail to teach or suggest extracting initiator-identifying information from the signaling message and including that information in the complaint registration message. Accordingly, for the same reasons stated above with regard to claims 1 and 26, it is respectfully submitted that claims 3, 5, 7, 16, and 29 are patentable over Ardon and Sloo.

Claims 13, 14, and 33 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ardon and Sloo in view of U.S. Patent No. 6,449,474 to Mukherjee et al. (hereinafter, "Mukherjee"). This rejection is respectfully traversed.

Claims 13, 14, and 33 depend from either claim 1 or claim 26. As stated above, Ardon and Sloo fail to teach automatically generating a complaint registration message from a user communications terminal or end office to which the initial communication is directed or including initiator-identifying information in the complaint registration message. Mukherjee likewise lacks such teaching or suggestion. Mukherjee is directed to a method for intercepting calls that uses an SCP database to correlate different numbers used by a subscriber. There is absolutely no teaching or suggestion of generating a complaint registration message, not to mention generating such a message from the equipment that detected the unwanted call. Accordingly, for this reason alone, the rejection of the claims as unpatentable over Ardon and Sloo in view of Mukherjee should be withdrawn.

Moreover, the Official Action indicates that column 7, lines 9-19 of Mukherjee disclose sending a violation notification message to an enforcement agency as claimed. Applicants respectfully disagree. Column 7, lines 9-24 of Mukherjee are as follows:

In response to the call using an IN service, the MSC will contact SCP 606 in providing the service. SCP 606 will identify the subscriber's account based on the PIN and password. The subscriber's number is contained in the subscriber's account information. SCP 606 will check to see if the subscriber's mobile number has been provisioned. If the number has been provisioned, the number will be returned to MSC 610. In turn, MSC 610 checks call intercept table 608 to find the entry corresponding to the returned number. Upon finding the entry, call intercept is initiated and a connection is made to law enforcement agency 614 as identified in the call intercept information in the entry for the number found in call intercept table 608. In this manner, the present invention allows call intercept for a call involving a subscriber's account in which the call does not use any number associated with the subscriber's number.

The above-quoted passage from Mukherjee indicates that a connection is made to a law enforcement agency. The connection referred to is a bearer channel connection that allows, the law enforcement agency is permitted to listen in on the call. There is absolutely no teaching or suggestion of transmitting a violation notification message to a law enforcement agency. Thus, for this addition reason, the rejection of claims 13, 14, and 33 should be withdrawn.

Claims 17-19, 23-25, 27, 28, 30, 37, 39, and 42 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ardon and Sloo in view of U.S. Patent No. 6,650,901 to Schuster et al. (hereinafter, "Schuster"). This rejection is respectfully traversed.

Claims 17-19, 23-25, 27, 28, 30, 37, 39, and 42 depend from one of claims 1, 20, and 26. As stated above, Arden and Sloo fail to teach automatically generating a complaint registration message from the same communications terminal to which the original

communication was directed, transmitting the complaint registration message to a complaint registration server, or including identifying information extracted from the signaling message in the complaint registration message. Schuster likewise lacks such teaching or suggestion. Schuster is directed to a method for providing PSTN services in a data network telephony system. The Examiner correctly notes that one of the features provided by Schuster is call blocking. However, there is absolutely no teaching or suggestion in Schuster of automatically generating a complaint registration message, transmitting the complaint registration message to a complaint registration server, or including identifying information extracted from the signaling message in the complaint registration message as claimed in the independent claims of the present application. Accordingly, the combination of Schuster, Ardon, and Sloo fail to teach the invention as claimed and the rejection of the claims 17-19, 23-25, 27, 28, 30, 37, 39, and 42 as unpatentable over Ardon and Sloo in view of Schuster should be withdrawn.

New Claims

New claims 43-46 are proposed to be added. New claims 43 and 44 depend from claim 1 and are patentable over all of the cited references for the same reasons stated above with regard to claim 1.

New independent claim 45 is directed to a method for generating a complaint registration message in response to a manual trigger by a user communications terminal. Support for new claim 45 is found, for example, in Figure 11 of the present application. New claim 45 is patentable over all of the references cited in the Official Action because none of the references disclose generating and sending a complaint registration message in

response to a manual trigger from the user communications terminal to which the unwanted communication that is the subject of the complaint is directed.

New independent claim 46 is directed to a complaint registration server that receives complaint registration messages relating to unwanted communications from user communications terminals. The complaint registration server identifies repeat offenders and transmits violation notification messages regarding the repeat offenders to an enforcement authority. Support for claim 46 is found, for example in Figure 12 of the present application. Claim 46 is patentable over the cited references because none of the references teach or suggest a complaint registration server that receives and processes complaint registration messages from terminals to which unwanted communications are directed.

CONCLUSION

In light of the above amendments and remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Official Action.

DEPOSIT ACCOUNT

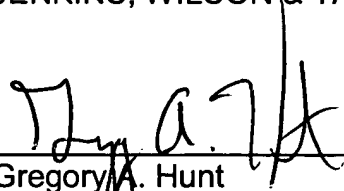
The Commissioner is hereby authorized to charge any fees associated with the filing of this correspondence to Deposit Account No. 50-0426.

Respectfully submitted,

JENKINS, WILSON & TAYLOR, P.A.

Date: October 29, 2004

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1322/62 GAH/sed/feb